

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. MOORE

Appeal No. 96-1874
Application 08/215,467¹

ON BRIEF

Before HAIRSTON, JERRY SMITH and CARMICHAEL, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's rejection of claims 1 and 2. Claims 3-5

¹ Application for patent filed March 21, 1994.

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have been indicated as containing allowable subject matter. Claims 6-8 have been allowed by the examiner. Although the appeal is nominally directed to claims 1-5, only claims 1 and 2 have been rejected by the examiner, and therefore, we consider the appeal as limited to claims 1 and 2.

The disclosed invention pertains to a protective cover for a firearm having a percussion cap mounted to a nipple thereon and a hammer for striking the percussion cap. The cover has a handle joined to it by a cantilevered connection which permits the cover to be bent out of alignment when force is applied to the handle. A loop of elastomeric material is connected to the handle and is attachable to a portion of the firearm.

Representative claim 1 is reproduced as follows:

1. A protective cover for a firearm having a percussion cap mounted to a nipple thereon and a hammer for striking said percussion cap, said cover being removably mounted over said percussion cap and between said hammer and said cap, said cover comprising:

a cover extending along a longitudinal axis and being formed from a waterproof material which is sufficiently resilient so as to permit said cover to be bendable off of that longitudinal axis,

said cover being closed at one end thereof and open at

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another end with an interior cavity being defined therebetween,

said interior cavity being sized so as to fit closely over said nipple,

a handle joined to said cover by a cantilevered connection at a point between the ends of said cover and extending substantially perpendicular to said longitudinal axis for a given length toward a free end,

said cantilevered connection extending for a relatively short length along said longitudinal axis and said given length being sufficiently long that application of force to the free end of said handle will permit said handle to move at least a portion of said cover out of alignment with said longitudinal axis, and

a loop member connected to said handle and formed from elastomeric material, said loop being dimensioned so as to be attachable to a portion of said firearm.

The examiner relies on the following references:

Haskins	35,418	May 27, 1862
Lunders	4,485,577	Dec. 04, 1984

Claims 1 and 2 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness the examiner offers Haskins in view of Lunders.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

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OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner has failed to provide a record which supports the obviousness of the invention as set forth in claims 1 and 2. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

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17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner's rejection basically takes the position that Haskins teaches all the features of independent claim 1 except for the loop member. Lunders is cited as teaching a

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loop member formed of elastomeric material. The examiner concludes that it would have been obvious to the artisan to employ the teachings of Lunders on the Haskins cover [answer, pages 4-5].

Appellant argues that there are two recitations of claim 1 which are not taught by the prior art combination as applied by the examiner. First, appellant argues that the handle in Haskins is not sufficiently cantilevered with respect to the cover that the application of force at the handle free end will move a portion of the cover out of alignment with the longitudinal axis of the rest of the cover. According to appellant, the examiner's position that the Haskins cover inherently possesses this property is without support in the Haskins disclosure. Second, appellant argues that the loop member of Lunders is not made from an elastomeric material. According to appellant, the leather material used for the Lunders loop is not an elastomeric material as claimed [brief, pages 5-7].

The examiner simply responds that the Haskins cover and handle inherently have the properties recited in claim 1,

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and that leather is known to exhibit the elastic properties of an elastomeric member [answer, pages 5-6].

In our view, the examiner's factual findings are not supported by the record in this case, and the examiner's rejection has failed to appropriately establish a prima facie case of obviousness.

With respect to the question of the cantilevered connection of the handle and whether the Haskins' device inherently possesses the property recited in claim 1, we are constrained to agree with appellant that the examiner has failed to support his case. Although the question should properly be whether the property recited in claim 1 would have been an obvious property to provide to the handle of a protective cover, this question has never been addressed. The obviousness issue got lost in the examiner's position that Haskins inherently has the property recited in claim 1.

We agree with appellant that there is no clear indication in Haskins that the handle and cover have the property recited in claim 1. The position that a force applied on Haskins' "handle" A would move a portion of the

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cover out of alignment with the longitudinal axis of the cover is pure speculation on the part of the examiner. There is no indication that the Haskins cover possesses this property, and we agree with appellant that the Figure 5 embodiment of Haskins suggests that such a property is not intended for the Haskins cover. We are not inclined to dispense with an appropriate showing of evidence where the examiner's reliance on inherency does not have clear factual support in the record.

With respect to the question of the loop being of elastomeric material, the examiner has again failed to properly address the question of obviousness. The appropriate question for review should be whether it would have been obvious to the artisan to use a loop made of elastomeric material with the Haskins cover. Instead, this question is left unaddressed by both the examiner and appellant.

The focus on the elasticity of the material is misplaced. The claim recites that the loop is made from an elastomeric material. An elastomer is a synthetic rubber. Thus, the

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claimed loop is made from a synthetic rubber material. The leather of Lunders is not an elastomeric material because leather is not a synthetic rubber. Whether it would have been obvious within the meaning of 35 U.S.C. § 103 to replace Lunders' leather material with an elastomeric material is a question which has not been briefed by the parties.

Although we cannot say whether there is prior art available which would suggest the obviousness of claims 1 and 2, we can say that the prior art applied by the examiner does not support the rejection as formulated by the examiner. Therefore, the decision of the examiner rejecting claims 1 and 2 under 35 U.S.C. § 103 is reversed.

REVERSED

PATENT

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF
Administrative Patent Judge)	APPEALS AND

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